

Application No.: 09/970,789

Reply to Office Action of October 17, 2007

### REMARKS

The final Office Action of October 17, 2007, has been carefully reviewed and these remarks are responsive thereto. Claims 11, 16-18, 22, 25, 31, and 35 have been amended to further clarify the scope of protection. Claims 56-58 are new. No new matter has been added. Claims 11-37, 42-51, and 56-58 are pending. Claims 52-55 have been canceled. Reconsideration and allowance of the instant application are respectfully requested.

#### *Comments Regarding Alleged Non-functional Descriptive Material*

Throughout the Office Action the Office summarily ignores various aspects of many claims as allegedly being directed to non-functional descriptive material. Applicants respectfully submit that summarily ignoring claim language in such a manner is improper.

For example, claim 31 recites database entries comprising:

a first field representative of a priority level,  
a second field representative of an arrival date,  
a third field representative of an importer name,  
a fourth field representative of a risk level, and  
a fifth field representative of a commodity name;

However, with respect to claim 31, the Office Action states:

the specific type of information within the database is considered to be non-functional descriptive material, and is related to the intended use of the database;

*Office Action, page 3*

If such logic were acceptable, data structure claims would never be allowable, because the Office could simply proffer a piece of prior art that had at least the same number of data fields irrespective of their relationship or what they stored. However, the Federal Circuit in *In re Lowry* explicitly affirmed that data structures are patentable subject matter when stored on a computer readable medium (which they are as claimed in the present case). In addition, the court in *In re Gulack* stated that:

Differences between an invention and the prior art cited against it *cannot be ignored merely because those differences reside in the content of the printed matter*. [The USPTO] cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. *The claim must be read as a whole*.

*In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983) (emphasis added).

The court went on to state that the critical question is whether there exists any new and unobvious *functional relationship* between the printed matter and the rest of the claim. In the

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present claims, there is clearly a functional relationship between what is stored and the rest of each claim in which a “non-functional descriptive material” argument is used by the Office. For example, claim 31 indicates that “each entry in the database is representative of a task,” and then goes on to claim computer executable instructions stored in memory, where one of the instructions states “displaying detailed task information on the display screen.” There is therefore a functional nexus between the material stored in the database and the rest of the claim. The same is also true for other claims where a non-functional descriptive material rejection has been alleged. Applicants therefore respectfully request that the Office properly examine the claims *as a whole*, as required by Federal Circuit precedent.

***Rejections Under 35 U.S.C. § 103(a)***

Pending claims 11-37 and 42-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McClelland (U.S. Patent No. 6,707,879, hereinafter *McClelland*) in view of Moore (U.S. Patent No. 6,246,778, hereinafter *Moore*). Applicants respectfully traverse.

The claim limitations of amended independent claims 11, 22, 31, and 35 are not taught or suggested by the prior art of record, even if combined. For example, claims 11 and 22 contain a step that includes receiving a task list “wherein each task comprises information known about a unique shipment of goods prior to the shipment being inspected.” Lee (U.S. Patent Publication No. 2003/0023469) does not include a client-side task list. *McClelland* makes no reference to using any pre-existing data. *Moore* is able to read a tag from the goods being inspected, but the authentication in *Moore* is based solely on the contents of this tag, which serves as a unique identifier. There is no notion of the tag containing information about the shipment of goods itself or of the field reader displaying any such information. Therefore, the prior art of record fails to teach or suggest the features of claims 11 and 22.

The Office Action alleges that, in *McClelland*, the x-raying of a shipment by a machine prior to the user’s review of that x-ray constitutes “information known about a unique shipment of goods prior to the shipment being inspected.” However, *an x-ray is an inspection*, and the x-ray information is not known until after the inspection takes place. Claim 11 clearly recites that “each task comprises information known about a unique shipment of goods *prior to the shipment being inspected*” (emphasis added). *McClelland* and *Moore* therefore do not make claim 11 obvious.

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Independent claims 22, 31, 35, and 42 recite similar features as claim 11 insofar as each task comprises information known about a unique shipment of goods prior to the shipment being inspected, and are therefore allowable at least for the same reasons as claim 11.

In addition, claims 31 and 35 include, among other features, a database wherein each entry is representative of a task. Such a database is not taught or suggested by the prior art of record. For at least the foregoing reasons, claims 11-37 and 43-51 are allowable.

Also, there is no motivation or suggestion to combine *McClelland* with *Moore*. The invention disclosed in *McClelland* enables spatial separation between the location of the goods and the location of the human inspector. This spatial separation is an essential part of the *McClelland* invention. The *McClelland* patent is titled “Remote Baggage Screening System, Software and Method” (emphasis added). In the “Summary of Invention” section, *McClelland* describes three embodiments of the invention. The first embodiment includes “a system for baggage screening that is remotely monitored and controlled.” (column 2, line 25). The second embodiment is described as being “for remote screening of items under inspection.” (column 2, line 46). The third is for “remote inspection of items.” (column 2, lines 63-64). This emphasis on the goods being remotely located teaches away from inspecting goods in person, as claimed. Consequently, there is no suggestion or motivation to combine *McClelland* with any reference that facilitates the in-person inspections *McClelland* was designed to avoid, such as *Moore*. Indeed, the “remote” aspects of *McClelland* are contrary to and would render the claimed invention unusable.

*Moore* attempts to facilitate the in-person inspection process *McClelland* tries to eliminate. As noted in the Office Action, *Moore* includes a field reader. Just as its name implies, the field reader is used in the field – at the location of the goods being inspected. Its features, such as displaying data obtained from a central server, would only be useful to someone performing an in-person inspection. There is no motivation or suggestion in either reference to combine *McClelland* and *Moore*. Applicants respectfully submit that the first prong of a *prima facie* case of obviousness has not been met, and therefore the reference teachings can not be combined in the first place.

Dependent claims 12-21, 23-30, 32-34, 36-37, and 43-51 are distinguishable over the prior art of record for at least the same reasons as their ultimate base claims and further in view of the novel features recited therein.

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***Conclusion***

Applicants respectfully submit that the instant application is in condition for allowance and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,  
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